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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1940.

No. 9.

SCHRIBER-SCHROTH COMPANY,

vs. Petitioner,

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,

Respondents.

No. 10.

ABERDEEN MOTOR SUPPLY COMPANY,

vs. Petitioner,

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,

Respondents.

No. 11.

F. E. ROWE SALES COMPANY,

vs. Petitioner,

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,

Respondents.

PETITIONERS' REPLY

To Plaintiffs' (Respondents') Motions to Remand and to Respondents' Petition for Rehearing.

This reply is to Respondent's Motions to Remand as well as to Respondent's Petition for Rehearing, because the Petition for Rehearing argues matters included in and in addition to those argued in Respondent's Motion to Remand.

THE QUESTION IS ONE OF CLAIM CONSTRUCTION AND NOT OF ABANDONMENT.

The question here is not one of abandonment of an invention of which notice must be given or pleaded in the Answer under R. S. 4920, Fifth (35 U. S. C. 69), but the question here is one of claim construction as affected by file wrapper estoppel, of which no notice need be given or pleaded.* While, therefore, this court used the expression, "abandoned claim" (p. 5), as we understand it, the basis of this Court's decision was that Jardine having "surrendered," "flexible" webs as a "feature" of the patented piston, as distinguishing from the prior art, Respondent cannot now contend that such is the distinguishing feature, nor that the claims should be construed as describing flexible webs.**

File wrapper estoppel simply means that where, during the prosecution of an application, the applicant and the Patent Office have agreed upon a claim to which the applicant is to be entitled, the patent owner will not, after the issue of the patent, consummating such an agreement, be permitted to change the scope of that claim in order to make out a case of either infringement or validity, by respectively broadening or narrowing the claim to suit the exigencies of

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*This was really covered by the Answer, for after paragraph 14 of the Bill (R. 8) had alleged that Jardine's alleged invention "had not been abandoned to the public," paragraph 14 of the Answer (R. 17), in response thereto, denied that "the statutory prerequisites had been complied with as alleged"; paragraphs 32 and 33 of the Answer (R. 23) alleged file wrapper estoppel and lack of disclaimer.

**This court has sometimes referred to a file wrapper estoppel as amounting to a "disclaimer" (p. 8), and sometimes referred to a claim to which a disclaimer had been entered as an "abandoned claim." Altoona v. Tri-Ergon, 294 U. S. 477, 492.

This Court's expressions are, for the convenience of this court, listed as follows: p. 5, "the flexible web feature," "claims pointing to flexible webs as a feature of his invention—later surrendered"; p. 7, "claims specifying flexing webs or their equivalents as a feature of the invention"; p. 8, "the surrendered flexible web feature of the patented combination," "the surrender of the former particularizing the flexible web feature of the alleged invention," "if the flexible web feature had not been surrendered."

Note: Emphasis in quoted parts throughout this brief is ours.

the case. This is illustrated by the following decisions, all of which, except one, were cited in this court's opinion (p. 8).

I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429, 443, was a case where the patentee was not allowed to broaden his claim over one previously rejected and canceled or amended, even though the limitation was not contained in one of the claims in suit, but was understood to be included by the applicant and the Patent Office.

Wm. B. Scaife & Sons v. Fall City Woolen Mills Company, 209 F. 210, 213, was a case where the limitation was included in another claim, but not in the claim in suit, and, therefore, it was held that such limitation could not be read into the claim in suit.

Morgan Envelope Co. v. Albany Paper Co., 152 U. S. 425, 429, was a case where the claim as originally presented contained the expression "substantially as described," but such expression was thereafter taken out of the claim. This court held that the claim could not thereafter be narrowed in court to the thing shown and described in the specification and drawings, in order to save it from invalidity. That case was cited with approval by this court in Altoona Theatre v. Tri-Ergon, 294 U. S. 477, 492.

Altoona Theatre v. Tri-Ergon Corp., 294 U. S. 477, 492, 493, was a case where a disclaimer had been entered to a claim, and even though this court held the disclaimer an improper and invalid disclaimer, it was nevertheless held by this court that the disclaimer could not be disregarded "to permit the abandoned claim to be revived."

Union Metallic Cartridge Company v. U. S. Cartridge Company, 112 U. S. 624 (not cited here, but cited with ap-

proval by this court in the Morgan-Albany case, as well as in the Altoona-Tri-Ergon case), was a case where the patentee had disclosed a cartridge loading machine, which embodied specifically a movable bunter and a stationary die. In a reissue of the patent, the patentee added a sentence to the specification which described the reverse arrangement, to wit: a movable die and a stationary bunter, as an alternative. A disclaimer was thereupon entered to the reissue patent, disclaiming "the movable die E as being the invention" of the patentee. The disclaimer did not make any specific change in the language of the claim, and it was not directed at any claim, but merely to the subject matter of the movable die. This court said:

> "The effect of the disclaimer was to limit the claims of the reissue to a machine with a stationary die E, shown in the original patent and drawings, and to prevent their any longer covering, even if they had before covered, a movable die E or bunter" (l. c. 643).

All of these cases illustrate the view of this court, that while ordinarily the claims of a patent are to be read or interpreted in the light of the specification, nevertheless the file wrapper history must always be considered to determine what was agreed upon between the applicant and the Patent Office, as claimed by the patent. Here it is clear from the file wrapper of the Jardine patent, as contained in this Record (R. 747-844), that flexible webs were intended to be excluded as limitations or restrictions from the claims of the Jardine patent, and that the claims were put forward to the public and to any defendant in any infringement suit, including these defendants, as not restricted to webs which were flexible.

The above cited decisions demonstrate that a patentee, who during the prosecution of his application before the Patent Office, deleted all claim reference to a given feature as patentably distinguishing his alleged invention from

the prior art, is just as definitely estopped from thereafter contending that in such feature rests the patentable distinction as, in the more usual case, he is estopped from contending that an added restriction should be disregarded.

THE FEATURES NOW STRESSED DO NOT MATERIALLY (PATENTABLY) DISTINGUISH THE JARDINE PATENT CLAIMS FROM THOSE LOST IN THE INTERFERENCES.

Respondent's counsel, in the Motion and in the Petition for Rehearing, seek to overcome the force of the file wrapper estoppel by contending that claims 1, 8 and 11 of the Jardine patent in suit distinguish from the claims which Jardine lost in interference, and particularly claim 18 (19E) taken as an example by this court, by the following:

(a) "retraction of the skirt from the bosses" and

(b) "balanced skirt flexibility."*

Such contention is made, although as found by this court (p. 9) neither of these restrictions is found in claims 1, 8 and 11, or constitutes a "material difference" (p. 7).

As to (b), "balanced skirt flexibility," this is certainly more apparent in claim 18 (19E), with its description of "skirt carriers * * * susceptible of being slightly **flexed** radially," than it is in claim 8 of the Jardine patent, which simply mentions "oppositely disposed webs." Furthermore, "balanced skirt flexibility" is simply a description of the result or mode of operation of a piston having flexing webs, which, as a feature, was surrendered with the flexing web feature, apart from the fact that it cannot be patented because, as this court said in De Forest Radio

*Three additional features are put forward in the Petition for Rehearing and these will be discussed later under (c), (d) and (e).

Company v. General Electric Co., 283 U. S. 684-5, cited in Petitioners' Brief (dated August 31, 1940, p. 46):

> "It is method and device which may be patented and not the scientific explanation of their operation."

As to feature (a),* we do not find that wording in any of the claims 1, 8 and 11. Claim 1 specifies "a skirt integral with said webs relieved adjacent said webs," which, in simple language, is a **"relief"** or depressed part in the regions of the bosses; indeed, it is so defined in Respondent's Petition for Rehearing (p. 6). But a relief was used in every trunk piston from the very beginning. It is described in the Franquist patent, illustrated in Petitioners' Brief, dated August 31, 1940 (p. 10). As a dashed-in relief, it is shown in the Schmiedeknecht patent as in Exhibit 1 (same Petitioners' Brief, p. 15); also in the Ricardo patent exactly as in the Jardine patent (same Petitioners' Brief, p. 11). It was in all of the Long pistons, and it was in all pistons from the very beginning.**

That the Court of Appeals found the distinguishing feature of the Jardine patent to reside in web flexibility and not in feature (a), "retraction of the skirt from the bosses," is clear from its second decision (p. 9, quoted by this court, p. 9), where, in holding invalid the Schmiedeknecht patent, which had that feature (see illustration, same Petitioners' Brief, p. 15), that court said:

> "It discloses no web flexibility co-operating with other elements of resiliency to achieve the balanced flexibility perceived in Jardine on the basis of which **alone** the latter is thought to be valid, and we sense

*The Court of Appeals' expression, quoted by this Court, page 8, was "flexing webs supporting retracted bosses and connected to a skirt."

**Chadwick testified (R. 139), "it has been done ever since I knew anything about gasoline engines," which was "about 1909." Respondent's witness, Burns, testified (R. 303), "you had to put a relief in there." Stellman testified, "those reliefs were in general use in 1915" (R. 263). Respondent's witness, Jeffries, admitted that pistons were relieved in the regions of the pin bosses as early as 1917 (R. 327).

no advance in Schmiedeknecht that distinguishes it from the prior art in aspects beyond the skill of the art. It does not invalidate Jardine and is itself invalid."

That is also clear from the second decision of the Court of Appeals (p. 9), holding the Maynard patent invalid as not "marking inventive step over prior art"; although that patent disclosed "retraction of the skirt from the bosses", and additionally separation of the thrust faces from the head, vertical slitting of one of the thrust faces, and attachment of the webs to a head flange provided with ring grooves, all as in Exhibit 1 (see illustrations, same Petitioners' Brief, p. 15).

This court said (p. 7) in comparing the claims:

"The only **material** difference in view of what has been said to be the invention is the statement in the withdrawn claims that the skirt carriers (webs) are 'susceptible of being slightly flexed radially' or the like."

The Practice in Interferences.

Respondent's counsel seek to treat a claim in an interference as if it was merely a collection of words rather than a description of something tangible. That is, however, not only contrary to common sense, but contrary to the decisions of the courts. In Re Dement, 263 F. 813, App. D. C., contains the following statement:

"The issue in an interference is not merely a claim which is distinct and separable from other claims which are or may be made on the same disclosure. The contest is over an **embodied invention, not a technical claim**" (l. c. 816).

There can be no doubt but that if Jardine had prevailed on the claims in interference he would have contended that "balanced skirt flexibility" and "retraction of skirt from the bosses" (that is, a relief whether a simple relief as in the Franquist patent or a dashed-in relief as in the Schmiedeknecht patent), should be read into the claims. As stated above, and as shown by the witnesses, such reliefs were in every piston from the beginning. It, therefore, follows that anyone skilled in the art would read such reliefs into the Long and Spillman disclosures, even if not shown or described, for in Honolulu v. Halliburton, 306 U. S. 550, 559, where such a situation arose, this court decided that the use of an old expedient "is necessarily implied from the language of the Franklin patent. Detailed description is not necessary."*

In the Dement case the situation was somewhat analogous, because after the interference had been terminated Dement sought to obtain claims of different scope, but the court says (263 F. 816):

> "The thing adjudicated was no doubt a thing different from the invention now claimed; but it was different only in scope of definition, as a simple pump differs from a double-acting pump."**

The difference between the claims which Jardine lost and the claims of the patent is not even as much as between a simple and a double-acting pump, because all pistons had reliefs in the regions of the bosses long before Jardine filed, and indeed before Gulick, Long and other parties to the interferences filed.

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*A recent decision by Judge Tuttle held that a relief on a piston, secured by cam grinding, should be read into a piston patent, even though it did not describe it. Berry v. Bohn Aluminum & Brass Corp., 29 F. Supp. 516, 520.

**That decision has been followed in later cases In re Wasserfallen, 298 F. 826, 828, App. D. C.; In Re Austin, 40 F. (2d) 756, 759, C. C. P. A.

Interferences With Gulick.

Not only was Jardine in interference with Long, Spillman and Hartog, but also with Gulick, on claims listed in Petitioners' Brief (p. 7), dated August 31, 1940, and claims 15 (16E) and 19 (20E), of the Jardine application, but lost in interferences, are claims 29 and 31 of the Gulick patent (R. 534). Gulick's claim 31 describes the Jardine piston, and claim 39 (quoted by this court, p. 2) and claim 18 (R. 532), cited by this court (p. 2), are detail descriptions of the Jardine piston. The Court of Appeals in its first decision (p. 5), described the Gulick piston in part as follows:

> "The wrist pin bosses are pulled inwardly from the skirt periphery and instead of being supported by the skirt are carried from the piston head by depending flanges, thus providing a vertically rigid support for the bosses with freedom of lateral motion in a direction at right angles to the load thrusts on the piston. The surface of the skirt where the bosses are connected to the head in conventional pistons was cut away or relieved, so that the bosses are not directly constrained by the cylinder wall."

Further, in distinguishing Jardine from Gulick, the Court of Appeals said (First Dec. p. 10):

> "He cut away all the skirt portions at the webs, extending the latter to nearly the length of the skirt parts or slippers."

As we showed in Petitioners' Brief (pp. 36-7), this was merely a step backwards in the art, in the direction of Ricardo and even Schmiedeknecht, as related to Exhibit 1 (Petitioners' Brief, p. 15).

It is, therefore, apparent that feature (a), "retraction of the skirt from the bosses," even to the extent of cutting away the skirt to produce a slipper piston, could not be a feature distinguishing the Jardine patent; and, as shown

above, feature (b), "balanced skirt flexibility," was found in all of the claims which Jardine lost in the interferences.

JARDINE WAS NOT ENTITLED TO THE CLAIMS OF THE PATENT.

It was well-settled law, at least as early as 1927, that an applicant, who had lost a claim in an interference, was not entitled to a claim which did not distinguish patentably from such the claim lost in interferences; In re Prichard, 23 F. (2) 768 (App. D. C.); and that a claim is not patentable over a claim lost in an interference, even if it contains limitations not found in the lost claim, unless it involves invention over the lost claim, and even over the structures of the prevailing applicants. In re Karplus, 97 F. (2) 100, 101 (CCPA).

The rule of election* also applies here, particularly with reference to the Gulick and Hartog patents, both of which issued to Respondent; the Gulick application was assigned before the interferences, while the Hartog application was apparently assigned later. Respondent elected to put the claims into the Gulick application, even the specific claim 18 (referred to in this Court's decision herein, p. 4), and claim 12,** which reads so much like claims 1, 8 and 11 of the Jardine patent, that it is difficult to distinguish them. The fact that all patents (Gulick, Hartog and Jardine) ended up in a common pool cannot help Respondent; and we have seen in this case the practice of Respondent of

*The rule of election was applied to a patent case involving a question of abandonment. Macbeth-Evans Co. v. General Electric Co., 246 F. 695, 701, citing Bierce v. Hutchins, 205 U. S. 340, 346.

**"12. A Piston comprising a head portion, a skirt portion, two separated pin bosses, connecting flanges in the zone of the bosses and extending from the bosses to the skirt on both sides of the bosses, connecting means from each of the bosses to the head portion, the skirt portion being entirely separated from the head portion except through the boss connections, and the skirt portion being split longitudinally of the piston to permit free expansion and contraction and the skirt portion being cut away adjacent the outer ends of the piston bosses."

successively renouncing and denouncing the successively expiring Spillman and Moors, Franquist and Schmiedeknecht patents, after they had served their purposes in suits against the customers of Sterling Products Company for the selling of Exhibit 1.*

Why the Examiner allowed the Jardine claims "does not appear," as this court observed (p. 8). Possibly, after the many interferences, which were conducted before the Examiner of Interferences, the Primary Examiner failed to appreciate the legal situation, which had only been settled a few years before. But whatever was the Examiner's reason for allowing the claims of the Jardine patent, the claims did not set forth a "**material** difference" over the claims which Jardine lost in the interferences, as this Court observed (p. 7). While there is a presumption of validity raised by the grant of a patent, such presumption is not conclusive and may be rebutted; Westinghouse Co. v. Formica Co., 266 U. S. 343, 348; and as this Court said in Andrews v. Hovey, 124 U. S. 694, 716:

> "But patents are often granted with a view of leaving open, to be decided by the courts, questions which the Patent Office does not deem it proper to adjudicate against the applicant by withholding the patent."**

*See Petitioner's Brief of September 17, 1938 (pp. 10 and 11) in Nos. 3, 4 and 5, October, 1938, Term, and Respondent's Brief in the instant case (p. 100).

**"Nor is this a case for the application of the doctrine, that, in cases of ambiguity, the practice adopted by an executive department of the Government in interpreting and administering a statute is to be taken as some evidence of its proper construction. The question before us, as to the validity of a patent, by reason of pre-existing acts or omissions of the inventor, of the character of those involved in the present case, is not a question of executive administration, but is properly a judicial question. Although it may be a question which, to some extent, may come under the cognizance of the Commissioner of Patents, in granting a patent, yet, like all the questions passed upon by him in granting a patent, which are similar in character to the question here involved, his determination thereof, in granting a particular patent, has never been looked upon as concluding the determination of the courts in regard to those questions, respecting such particular patent, and, a fortiori, respecting other patents" (124 U. S., l. c. 716).

THE AFFIDAVITS OF WATTS AND ROBERTSON DO NOT WARRANT A DIFFERENT DECISION NOR A REMAND.

The affidavit of Mr. Watts does not add facts of such a nature as to warrant a different decision, even if we assume all of the facts stated therein to be correct. Mr. Watts' statement that the Long and Spillman patents did not describe and show reliefs in the regions of the wrist pin bosses can make no difference; for anyone in this art would inevitably read such reliefs into their disclosures, and legally it is presumed that that would be done. Assuming that neither the Long nor the Spillman applications in interference disclosed flexible webs, that does not overcome the legal situation that Jardine lost claims in the interferences, including flexible webs, and under the law he was not entitled to reclaim such claims, either as written, or with such variations as did not amount to invention. Moreover, Hartog clearly disclosed flexible webs, as the Court of Appeals found.

The affidavit of Mr. Robertson does not add facts of such a nature as to warrant a different decision, even if we assume all the facts stated therein to be correct, although Robertson only states that he has "examined the drawings of the Long and Spillman applications." The conclusion that the Patent Office, in an interference, would not have read into any piston application such a well-known thing as a relief in the regions of the bosses, is contrary to the decision in Cosper v. Gold and Gold, 1911 C. D. 387 (36 App. D. C. 302), where the Court says (l. c. 395):

> "We attach no importance to the failure to give a representation of the car in connection with the foregoing drawing. It is not necessary to add a drawing of that which was well known to every one whether skilled in the art or not. This reasonable doctrine,

well established in the Patent Office, has been repeatedly sanctioned by this court. (Kilbourn v. Hirner, C. D. 1907 552; 128 O. G. 1689; 20 App. D. C. 54; Hopkins v. Newman, C. D. 1908 395; 134 O. G. 2028; 30 App. D. C. 402, and cases cited.)"

That view has been followed in a late decision of the Court of Customs & Patent Appeals in Creed v. Potts, 96 F. (2) 317. That was the view of this court in Honolulu Corp. v. Halliburton, 306 U. S. 550, 559, supra. Such a view is not contrary to this Court's first decision in this case with reference to the Gulick patent. Such a common relief was not found by the Court of Appeals to be a distinguishing characteristic of the Jardine patent, as the Court of Appeals made clear when disposing of the Schmiedeknecht patent, as previously shown. Accordingly, here we do not have a situation where, as this Court's first decision, 305 U. S. (l. c. 58), "invention depends on emphasis of one quality over the other, as the court below found was the case with the laterally flexible webs in the Gulick device."

The facts stated in the Affidavits of Watts and Robertson, even if given full force and effect, cannot result in a reversal. Questions of validity, patentability and scope of claims are questions of law, involving constructions of the patent statutes; and it is the construction of the statutes which is here involved.

RESPONDENT'S SHIFTING POSITIONS IN THIS CASE.

It is next contended that the defense of abandonment was not pleaded, placed in issue, no evidence submitted, except incidentally, but that the evidence is insufficient; that it was never argued and never decided. As we have, however, shown the question here is not one of abandonment, but of the construction of claims as affected by file

wrapper estoppel, and the record is replete with evidence in the form of the file wrapper and contents of the Jardine application, which is the only evidence pertinent.

While, as noted in Petitioners' Brief (pp. 39 and 41), the Court of Appeals in finally distinguishing from the Hartog patent restricted Jardine's claims to "the bending or flexing of straight ribs (webs) so proportioned as to yield to the thermal expansion of the bosses on the cantilever principle"; such was not the position of Respondent before the District Court, nor before the Court of Appeals to the last ditch, nor before this Court in this case.

It will be seen from the Master's Report (R. 382), there were a number of pistons alleged to infringe the Jardine patent, including Exhibit CCC, as well as Exhibit 1, described by the Master, and the Master listed Jardine's claims 1, 8 and 10 as against Exhibit CCC (R. 361).* Respondent's witness Jeffries described Exhibit CCC (R. 77, 93-4, 334), and contended that Exhibit CCC had the web structure of the Jardine patent. As to Exhibit 1, Respondent's witness, Jeffries, contended that the web extended into the Keystone relief, that is, into the thrust face (67, 88, 326, 345). That did not make Exhibit 1 correspond with the structure that the Court of Appeals found the distinguishing feature of the Jardine patent, i. e., "straight ribs—to yield—on the cantilever principle."**

In Respondent's Main Brief before the Court of Appeals (see Appendix pp. I-V), the following assertions were made, namely: that the web of Exhibit 1 extended into the thrust face (p. 69); that claims 1, 8 and 11 were infringed by Ex-

*Exhibit CCC is illustrated in the Appendix (p. V), as it appeared in Respondent's Brief before the Court of Appeals; the physical exhibit is before this Court.

**The Master's Report further shows (R. 361) that a Ray Day piston, Exhibit 8, was relied on as infringing the Jardine patent. It is shown in the Appendix (p. VI) (taken from Respondent's brief before the Court of Appeals) and is described by the Master (R. 383).

hibit CCC, as well as by Exhibit 1 (p. 75); note particularly the application of the claims to Exhibits 1 and CCC (pp. 186, 191, 194). In Respondent's Main Brief on the second appeal (see Appendix p. VII), web flexibility was not particularly relied upon (p. 39), although Exhibit CCC, as well as Exhibit 1, were relied upon as infringing the Jardine patent (pp. 40 and 50). In Respondent's Reply Brief on the second appeal (Appendix pp. VIII-IX) it was even stated that the Jardine patent claims do not recite flexing webs (pp. 14-15).

Even before this court, preceding this Court's last decision (see Respondent's Brief, pp. 30, 45, 46 and 51), it was contended that the Court of Appeals did not find the distinguishing feature of the Jardine patent to reside in flexible webs; that it was not necessary to so construe the claims to avoid the prior art; and that this is not even essential. Even the Petition for Rehearing states (p. 5) "in this very litigation this Court has affirmed and applied the rule that a limitation cannot be read into a claim."

The fact is that Respondent has changed its position throughout the conduct of this case. This is not permissible; Ohio & Mississippi Railway Co. v. McCarthy, 96 U. S. 258, 267; American Signal Corp. v. International Roll-Call Systems, Inc., 110 F. (2) 942. In the last cited case Judge Dobie's language is particularly pertinent here when he said:

> "Plaintiff here, we think, is upon the horns of an embarrassing dilemma. If these claims be very broadly construed (which plaintiff's counsel at first asked in oral argument), then we think the patents in suit would be invalid under the prior art as manifested in the Bobson patents. If these claims be rather narrowly construed (which we think is proper), then we are convinced that the differences between the devices of plaintiff and the devices of defendants

are so many in number and so striking in character that there is no infringement * * *."

With such positions taken by Respondents before the Master, the District Court and the Circuit Court of Appeals and even before this Court, it comes with bad grace for Respondents' counsel to now ask this court to remand this cause, because Respondents have not introduced sufficient evidence to support a shifted position.

The Master specifically discussed Jardine with reference to Long and the Interference in which Jardine was involved with Long (R. 428).

The Appendix further shows that before the Circuit Court of Appeals Petitioners argued the very question presented in the Writ for Certiorari; see Petitioners' Supplemental Brief (pp. 4, 25-29, 44-45), reproduced in the Appendix (pp. IX-XIII).

There was no shift in position on the part of Petitioners, for the claims of the Jardine patent, as drawn, were fully anticipated by the prior art. It was not incumbent upon Petitioners to meet a possible shift of position after a contention to the last ditch on the part of Respondent, that things like Exhibits 1 and CCC were infringements, that web flexibility need not be read into the Jardine patent, and that the claims were valid without that. Furthermore, any Appellate Court can decide a cause upon a different ground than decided by the lower court.

It is, therefore, respectfully submitted that there is no ground stated in Respondents' Motion to Remand these causes to the trial court, to either adduce additional evidence or to rule upon any question, to warrant a remand. The evidence is before this court in the form of the file wrapper and contents of the Jardine patent, and the addi-

tional facts set forth in the affidavits of Watts and Robertson cannot result in a different decision.

ADDITIONAL CONTENTIONS IN RESPONDENT'S PETITION FOR REHEARING.

In addition to the features put forward by Respondents in their Motion as distinguishing the Jardine patent claims from interference claim 18 (19E); i. e.,

(a) "retraction of the skirt from the bosses,"

(b) "balanced skirt flexibility,"

which were repeated in the Petition for Rehearing, three additional features are now put forward, which, for convenience, will be designated as follows:

c. **Two** circumferential slits separating the head from the skirt.

d. A longitudinal slit between the ends of the webs and in or **near the center** of the thrust face of the piston.

e. Attachment of the webs to the **head flange** carrying the ring grooves.

(c) **Two circumferential slits** separating the head from the skirt are also stressed in Respondent's Petition (p. 21) as distinguishing the Jardine claims from interference claim 18 (19E). Curiously, the piston of the Maynard patent put forward as being a Jardine piston and originally alleged to have been copied by Exhibit 1, describes this as "a groove E, which extends completely around the same," and this is claimed as "a continuous annular groove" (R. 547, lines 50, 101). In the Ray Day piston (see Appendix p. VI), alleged to infringe the Jardine patent (R. 361), the slit was continuous.

Apart from the fact that Respondent has thus shifted its position, not only were two circumferential slits de-

scribed in the Long patent 1,872,772 (R. 717), but they are found in the Long commercial pistons, to say nothing of Franquist (R. 699), Ricardo (R. 704), and Pomeroy (R. 733). Surely that was not a material difference from a patentable standpoint, when it was such a common feature, and there can be no doubt that if Jardine had prevailed in the interferences, Respondent would have contended that the continuous slits or grooves of Spillman and of Gulick were within the Jardine patent claims. Of course, that feature was brought up for the first time in the Petition for Rehearing.

(d) **A longitudinal slit** between the ends of the webs and "in or near the **center** of the thrust face of the piston" is also stressed in Respondent's Petition for Rehearing (p. 22) as a feature distinguishing from interference claim 18 (19E), although such wording does not appear in the claims; indeed, Respondent's witness testified that such a feature was not material (R. 69-70).* The Long patent and the Long commercial pistons all showed this feature, as also did Gulick. The language of claim 1 of the Jardine patent is really found in claim 18 of the Gulick patent (R. 532). The Jardine patent does not stress where the vertical slit should be, and it shows it inclined, with the top nearer one web than the other. Again, that feature can constitute no material difference from a patentable standpoint, and, again, this was brought up for the first time in the Petition for Rehearing.

(e) **Attachment of the webs to the head flange** of a piston, which flange is provided with ring grooves, is also stressed in Respondent's Petition for Rehearing (pp. 19-21) as a feature distinguishing the claims of the Jardine patent from interference claim 18 (19E), although that feature is only found in claims 8 and 11.

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*"A. Whether it is exactly in the center or not I think makes much less difference than it does whether it may be opposite the wrist pin bosses; that is, the slot should be between the wrist pin bosses."

In Sheet 2 of the Jardine patent (R. 540) the webs 6 extend directly up to the head inside of the ring flange, and there are cross ribs 9 connecting these webs with the flange, as shown in Figure 3. It is not clear what the construction of sheet 2 is, although there are cross ribs 29a in Figure 7 corresponding to the cross ribs 9 of Figure 3. What is meant by the statement in claim 11 "webs integral with the flange extending **convergingly inward** of the piston from the opposite portions of the flange" is not clear, since there is no description of that in the specification, pointing by a reference character to the drawing, unless it is meant that the webs are spaced from the inside of the ring flange as in Gulick.

While in the Hartog patent (R. 726) the flange 12 is not connected to the head flange by a rib, and while the piston head has a short flange not provided with ring grooves, there is a ring 20, shown in Figure 5 and also in Figure 2, for entering the circumferential slot 16 between the head and the skirt. It was, however, common to provide the piston head with a depending flange; that is shown not only in the Gulick patent, in interference with Jardine, but also in the Long patent and pistons.

The Gulick piston (R. 529, Figure 2) not only has a ring flange but also has ribs corresponding to the ribs 9 and 27a of Jardine, although these ribs do not extend completely up to the ring-carrying flange on the head. Claim 31 of the Gulick patent, which was claim 19 (20E), lost by Jardine in the Interference, specifies "a piston having a head with top and **side walls**, in combination with a guide structure connected thereto."

In the Schmiedeknecht patent (R. 551) webs are joined to the head through the medium of the bosses. In the Franquist patent (R. 699) the skirt is left connected to the ring flange in the regions of the bosses.

The Pomeroy patent, No. 1,499,073 (R. 733), appears to have exact construction of the Jardine piston in this respect, as shown in Figure 1, and the Specification specifically describes (R. 733, lines 84-89):

> "a pair of webs 6, 6 which join the slippers and bosses together and extend upward and merge with the crown and side wall of the head section of the piston, the entire piston being cast in one."

The "side wall of the head section" is referred to in line 78 by the reference numeral 1^b, which is what the Jardine claims call a "cylindrical ring flange." It will further be noted that in this Pomeroy patent the webs are yielding webs, as specifically described by Pomeroy (R. 734, line 19). This Pomeroy patent not only has a filing date prior to the date of Jardine, but Pomeroy's work preceded Jardine, as admitted by Respondent's witness, Jeffries (R. 84-6), who also admitted that the Pomeroy piston was not only actually made, that it had flexible webs, that it was cast in a permanent mold, but also that the overhang of the flange, with reference to the web, was eliminated. The Pomeroy application was in Interference with Hartog on a claim including flexible webs, as noted in the Record (R. 746).*

This is, therefore, another instance where Respondent relies upon a feature not enumerated in claim 18 (19E), although that feature was in practically every piston prior to Jardine, as were the reliefs in the regions of the wrist pin bosses. Finally it was claim 19 (20E), which Jardine lost in Interference with Gulick and that claim appears in the Gulick patent, and the disclosure of Gulick is as pertinent as the disclosure of Jardine.

---

*This claim was copied by Jardine as claim 15 (16E) (R. 789); that claim was involved in Jardine's interference with Gulick, Long and Hartog (Petitioner's Brief, p. 7); after an adverse decision this claim was cancelled by Jardine (R. 834) and appears as claim 29 of the Gulick patent (R. 534).

Relative breadth of claims of the Jardine patent and the claims which Jardine lost in interference is stressed in Respondent's Petition for Rehearing (pp. 16, 25), although the features stressed are not in the Jardine patent claims, as this court found (p. 9). However, the interference claim did have a foundation for "balanced skirt flexibility" in the statement "susceptible of being slightly flexed radially," and in that respect was more specific than the claims of the Jardine patent. As to the feature of "retraction of the skirt from the bosses," Respondent's petition (p. 6) admits that difference is just a "relief," which, as we have shown, was not only old, but ancient, so that the claims of the Jardine patent could not be considered more specific patentably in that respect.

The Hartog patent is discussed in Respondent's Petition for Rehearing (pp. 9, 10, 11 and 12). The contention that the expression in the interference claim 19E "skirt carriers . . . susceptible of being slightly flexed radially" is not applicable to Jardine's webs is rather late, apart from the fact that "radially" obviously means on some radius by the swinging of the web at its point of attachment which, in Hartog, as well as in Jardine, is at the point of support of the web. Reference to Hartog's Figure 1 shows that the web is mounted to flex as a cantilever from its point of attachment to the part attached to the head.

A distinction in terminology is sought to be made between "ribs," "arms," "webs" and "skirt carriers" as used in the various claims in the interferences, the expression in claim 18 (19E), selected by this court, being "skirt carriers." It is then sought to apply to the web, as used in the Jardine patent claims, a specific meaning; indeed, it is intimated in the Petition (p. 15), that the webs should be limited to that "shown and described," although ap-

parently still insisting that Exhibit 1 should come within the Jardine patent. Here we again have a shift in position. The contention before the Master and through the Circuit Court of Appeals on both appeals was not only that the Jardine patent was infringed by Exhibit 1, assuming the end of the web curved and with the web proper an eighth of an inch long, but that Exhibit CCC, which was simply a trunk piston with reliefs giving curved faces, was also infringed.*

A claim as a composite unit is stressed in Respondent's Petition for Rehearing, as if there were something magical about a combination claim. That is not true for, under the law, a combination must involve invention. A case practically on all fours with this case is the recent decision of this court in Textile Machine Works v. Hirsch Co., 302 U. S. 490, 497-8, where this court says:

> "The addition of a new and useful element to an old combination may be patentable; but the addition must be the result of invention rather than the mere exercise of the skill of the calling, and not one plainly indicated by the prior art. Electric Cable Joint Co. v. Brooklyn Edison Co., 292 U. S. 69, 79, 80; Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U. S. 477, 486."

The Altoona case cited involved the addition of an old expedient, namely, a flywheel, to a talking picture machine in order to secure continuity and uniformity of motion. This court says:

> "The patentees brought together old elements, in a mechanism involving no new principle, to produce an

*Exhibits 1 and CCC are illustrated in the Appendix (p. V) as taken from Respondent's Brief before the Circuit Court of Appeals on the first appeal, together with the claims of the Jardine patent directed to those pistons.

> old result, greater uniformity of motion. However skillfully this was done, and even though there was produced a machine of greater precision and a higher degree of motion-constancy, and hence one more useful in the art, it was still the product of skill, not of invention."

In the Textile Machine Works case this Court refers to the "art of machine design in the knitting machine field," 302 U. S. 498, and in the Altoona case to a "procedure in the field of mechanics and machine design." In Hansen v. Slick, 230 F. 627 (C. C. A. 3), l. c. 632, the Court said: "Invention is what rises to a higher plane than skill, both engineering and mechanical."

Here the various expedients which are put forward as distinguishing the claims of the Jardine patent from the claims which Jardine lost in interference, such as reliefs in the regions of the bosses, two circumferential slits instead of a continuous slit, a vertical slit midway between webs, and connection of the webs to the ring flange, were not only old, but ancient, and would have been applied by any skilled mechanic to a piston covered by the claims which Jardine lost in interference, to say nothing of the various structures disclosed in the other applications. Surely, when Jardine lost those claims it is absurd to say that those skilled in the art were not free to utilize those common expedients.

This Court's statement (p. 7) that "at no time during the prosecution of the Jardine application did he urge that he was the inventor of a piston having flexible webs," but criticized in Respondent's Petition for Rehearing (p. 14), is substantiated by the Record. The file wrapper shows that the original claims (R. 755-8) did not mention flexible webs, so that the original Oath (R. 758) did not support

Respondent's contention. The Supplemental Oaths (R. 766, 772) supported claims not specifying flexible webs. No Supplemental Oath accompanied the claims, including flexible webs (R. 788-790), and which were later put in interference and lost by Jardine. Claims 3-12 of the patent (R. 834-838) did specify flexible webs, but, even so, were not supported by a Supplemental Oath.

1/1000th of an inch clearance is again stressed in Respondent's Petition for Rehearing (p. 8 and elsewhere), as it was in Respondent's Brief before the hearing and at the hearing, although, as pointed out in Petitioners' Reply Brief (p. 11) and at the hearing, there was no evidence that any Jardine piston ever operated commercially or could operate at that clearance. Of course, no reference to any record pages are given in the Petition for Rehearing.

Mistakes in the opinion are referred to in Respondent's Petition for Rehearing (pp. 29-30). As to 1, having reference to page 2 of the opinion, we believe that this can readily be corrected so as to conform with the first opinion by omitting the words "which the court sustained" in the paragraph ahead of the quoted claim, for while claim 39 was not in suit, claim 18 was. As to 2, referring to page 6 of this Court's opinion, there is neither error nor mistake. Claims 5 and 6 actually do contain the statements quoted, while claims 8 and 11 do not. Moreover, as noted in the Master's Report (R. 1096), claims 5 and 6, together with claims 1, 8 and 11, were actually listed as being infringed by Exhibit 1, and claims 1, 8 and 11 were simply selected before the Court of Appeals as typical claims. With reference to page 3 of this Court's opinion, we believe that the insertion of "without prejudice" after "missal," line 4 from the bottom, will clarify the situation. We make these suggestions for the convenience of this Court.

CONCLUSION.

The shifting positions of Respondent during this litigation have been noted. First, Jardine was put forward as covering no less than four pistons, as listed by the Master (R. 361) and described by the Master (R. 381-2), including a piston, Exhibit 1, having a web one-eighth of an inch long, but which Respondent contended should be extended into the thrust face; a plain trunk piston, Exhibit CCC, relieved in the regions of the bosses, the curved side walls of which were put forward as Jardine's webs; and even a Ray Day piston, Exhibit 8, which had an inside connection from the head to the boss.* The Hartog piston is then sought to be excluded, because a part of the web is curved. The Hartog and Pomeroy webs are said to be too flexible, although the Master held (R. 382) the web of Exhibit 1 is stiff as shown in Petitioners' Brief (dated August 31, 1940, p. 26). Where the limit of interpretation should be, with reference to the web, Petitioners' counsel cannot tell from Respondent's argument. Perhaps Respondent wants a court to decide that the web of the Jardine patent is not as flexible as the webs of Hartog or Pomeroy pistons, but is as flexible as is the web of Exhibit 1; or perhaps that the curve from the web of Exhibit 1 extending into the relief is not as much as the curve of the Hartog web. Of course, the situation is here such that reference to the specification will not help to determine either validity or infringement, and the claims simply do not comply with R. S. 4888 and cannot be made to comply therewith.

There is nothing in this Court's opinion which will have a revolutionary effect upon some rule of law or some established procedure, as is intimated in Respondent's Petition

*These are illustrated in the Appendix (pp. V-VI) as presented by Respondents to the Circuit Court of Appeals.

for Rehearing (p. 29). The basis of this Court's decision, as we understand it, is not that claim 8 of the Jardine patent and claim 19E are the same, but that there is no material (patentable) difference between them when both of them are construed in connection with a specification. Surely claim 19E would be more definite in the Jardine specification than claim 8, for claim 8 does not specify web flexibility, while claim 19E does. Such a feature as relief in the regions of the bosses which Respondent's counsel say is in claim 8 and not in claim 19E, would be read by any court into a piston patent, even without reference to a specification, and, of course, that is more so true of balanced flexibility with reference to claim 19E than with reference to claim 8.

The purpose of the Statute, R. S. 4888, is to enable not only courts to construe what a patent covers, but to enable patent counsel to advise clients. The defenses against a patent are generally two, namely, invalidity and non-infringement; as the basis therefor reliance must be had upon the prior art and upon the file wrapper history. The file history, in almost every case, will show an entirely different situation than the patent specification and claims alone will do, for the file history shows what has been surrendered during the prosecution of the application.

The present case is not one where an injustice has been done to Respondent, but the opposite. The Jardine patent was not originally put forward at all in the Patent Office or in this litigation as anything substantial, because both Hartog and Long were prior to Jardine, as was also Gulick. Respondent knowing this, deliberately relied upon the Gulick patent with its early filing date and distorted the description (by amendment) to eliminate both Hartog and Long. Now that this distortion has been disapproved by this court, Respondent cannot complain if the situation,

which itself has created, turns to be unfavorable to Respondent. Furthermore, as shown in Petitioner's Brief, by no twisting of Jardine's claims can these claims be held valid and still be infringed by Exhibit 1.

It is therefore respectfully submitted that Respondent's motion to remand and Respondent's petition for rehearing should be denied.

Respectfully submitted,

JOHN H. BRUNINGA,
JOHN H. SUTHERLAND,
Attorneys for Petitioners.

St. Louis,
January 15, 1941.

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APPENDIX.

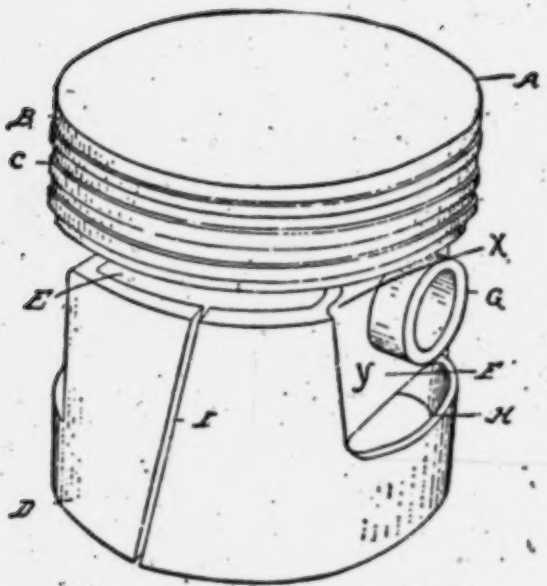


Fig. 1 (Maynard Piston)

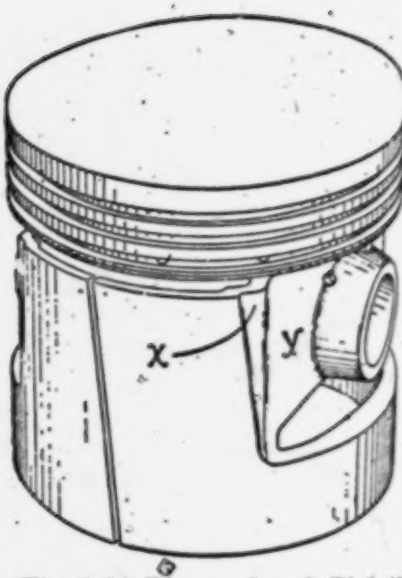


Fig. 2 (A Piston of each Plaintiff and Defendants)

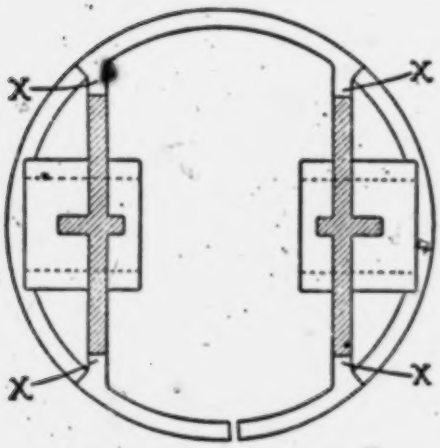


Fig. 3 (Maynard Piston)

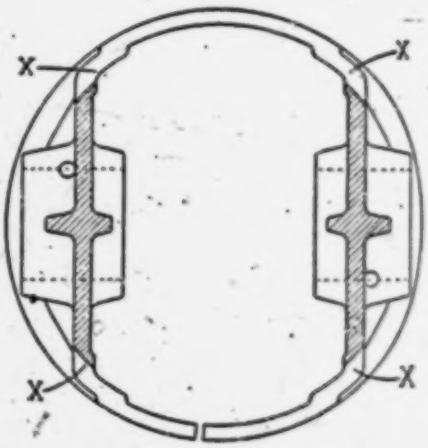


Fig. 4 (A Piston of each Plaintiff and Defendants)

APPENDIX.

MAIN BRIEF FOR APPELLANTS.

Page 69:

The first piston thus duplicated was the Maynard piston and as typical of the questions of infringement involved, we submit opposite, as Fig. 1, a drawing from the Maynard patent and Fig. 2, a drawing of defendants' piston Exhibit 1 charged to infringe the Maynard patent.

The undisputed evidence is that the pistons are precisely the same in mode of operation and results, in function and in structure except that the edge X is cut away in defendants' piston due to the fact that plaintiff's licensees had done this long prior to the copying by defendants of plaintiff's licensees' commercial piston. There is no denial of the evidence of our witnesses that operations, functions and results are the same and that structures are identical except for this dulling of the corner at X. (R. pp. 81-84.) Or, looking at it in another way, the only differences between these two are that in Maynard the web is straight from end to end, as shown at X, and in Exhibit 1 this web is slightly curved in at the ends as shown at X in the cross sections opposite, Figs. 3 and 4, which are taken between the bosses and the head of the piston.

Page 74:

Claims in Suit: The example claims in suit to which we referred, *supra*, are as follows:

Gulick: Claims 1, 11, 12, 13, 15, 18, 28, 29, 30 and 33. All but claim 33 were involved in one or more of the interferences to which we have referred. Claims 11, 12, 13, 18, 29 and 30 are limited broadly or narrowly to the webs.

Jardine:	Claims 1, 8 and 11.
Maynard:	Claims 1, 6 and 8.
Mooers:	Claims 4 and 6.
Schmiedeknecht:	Claims 1 and 3.

Page 75:

Exhibit No. 1 with all patents in suit. (R. pp. 80-84.)

Exhibit No. 8 with Gulick, Jardine and Mooers. (R. pp. 85 and 86.)

Exhibit BBB with all patents in suit. (R. pp. 190-191.)

Exhibit CCC with Gulick, Jardine, Maynard and Mooers. (R. pp. 199-201.)

Exhibit 3-J with Gulick. R. pp. 955 and 956.)

Exhibit 3-O with Gulick and Mooers. (R. pp. 956 and 957.)

Page 77:

(4) Defendants' expert admits the presence of the webs in Exhibits BBB, CCC and 3-J. (R. p. 535.) There never was a denial that webs are present in Exhibit 1.

(5) Defendants' expert points out the extension of the keystone relief at X in Fig. 2 and the bending of the ends of the webs there, but admits that a web is still a web when curved from end to end in the admission pointed out in No. 4. This keystone relief, present in Maynard and defendants' pistons, is in none of the claims in suit.

Page 82:

Therefore, the Master was quite wrong in saying that all of the claims in Gulick and Jardine were limited to webs, that any of them were limited to webs flexible throughout, that the defendants' pistons (Except Ex. 3-O) did not have webs, and that the webs which the defendants' pistons do have were nof flexible throughout. There is no evidence in the record to support any of these findings. Every one involving fact is contrary to the testimony of the defendants' expert, as well as the other witnesses testifying on that subject.

Page 186:

Jardine Patent No. 1,763,523:

Claim 1. In a piston for an internal combustion engine, the combination of

Infringed by Exhibits 1 BBB CCC

1. a head (1) having ring grooves (side wall 1[b] of head having packing ring grooves) therein,
2. a plurality of webs (5) integral with said head (1) and having
3. diametrically opposite piston pin bosses (4) therein,
4. a skirt (2)
   a. integral with said webs relieved (relieved area 7) adjacent said webs (5) and
   b. separated from the head (1) by circumferential slots (3) and provided with
   c. a longitudinal slot (8) connecting the lower end of the piston with one of the circumferential slots (3).

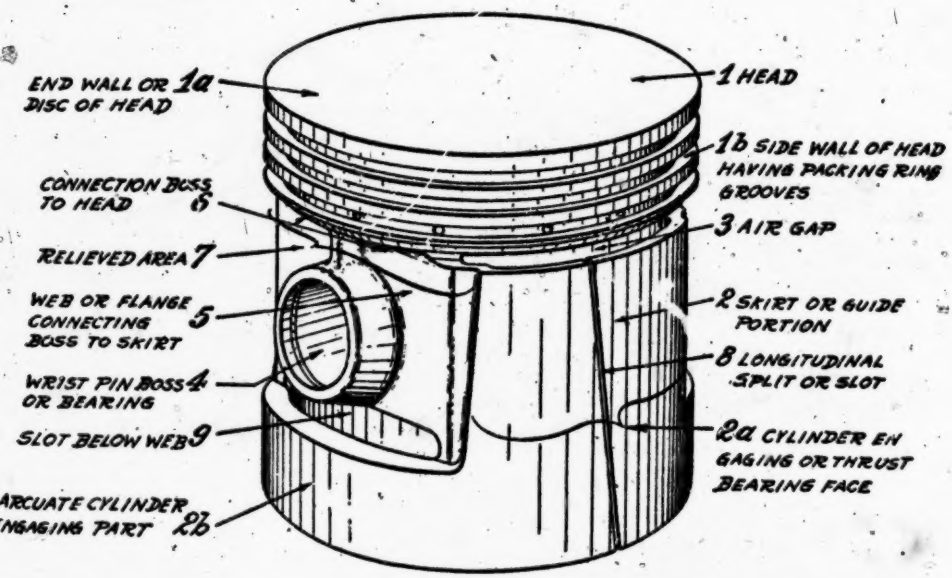
Claim 8. In a piston for an internal combustion engine, the combination of

Infringed by Exhibits 1 BBB CCC

1. a head (1) having a cylindrical ring flange (1[b])
2. oppositely disposed webs (5) integral with the flange (1[b]) and carrying diametrically opposite piston pin bosses (4),
3. a skirt (2) integral with said webs (5) and
   a. cut away to expose the sides of said webs (5) and
   b. separated from the ring flange (1[b]) by circumferential slits (3) and
   c. provided with a longitudinal slit (8) disposed between the ends of the webs (5).

Tightly Bound

Page 191: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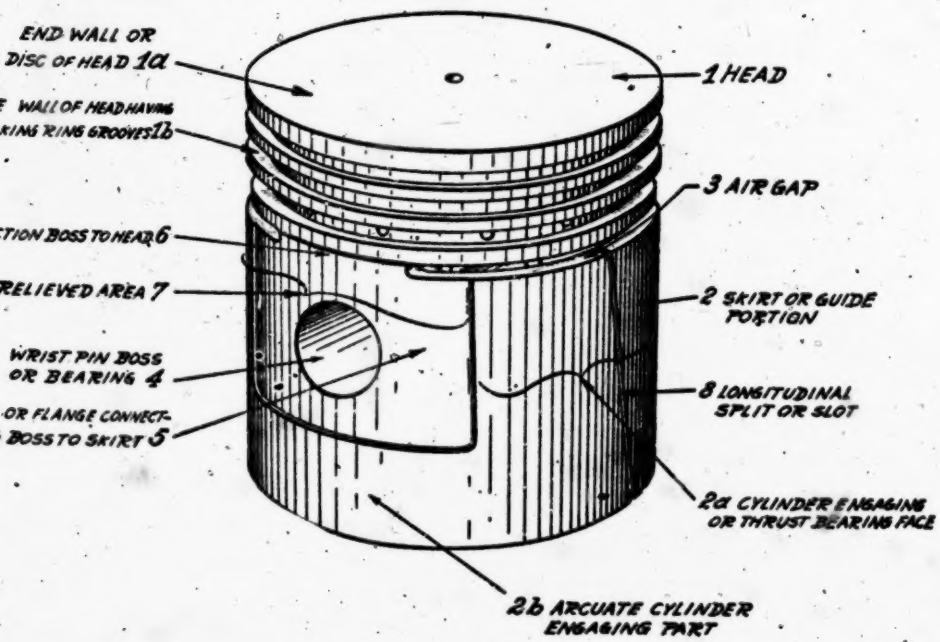
1 HEAD
1b SIDE WALL OF HEAD HAVING PACKING RING GROOVES
CONNECTION BOSS TO HEAD 6
3 AIR GAP
RELIEVED AREA 7
2 SKIRT OR GUIDE PORTION
WEB OR FLANGE CONNECTING BOSS TO SKIRT 5
8 LONGITUDINAL SPLIT OR SLOT
WRIST PIN BOSS OR BEARING 4
SLOT BELOW WEB 9
2a CYLINDER EN GAGING OR THRUST BEARING FACE
ARCUATE CYLINDER NGAGING PART 2b

EXHIBIT 1

Page 194: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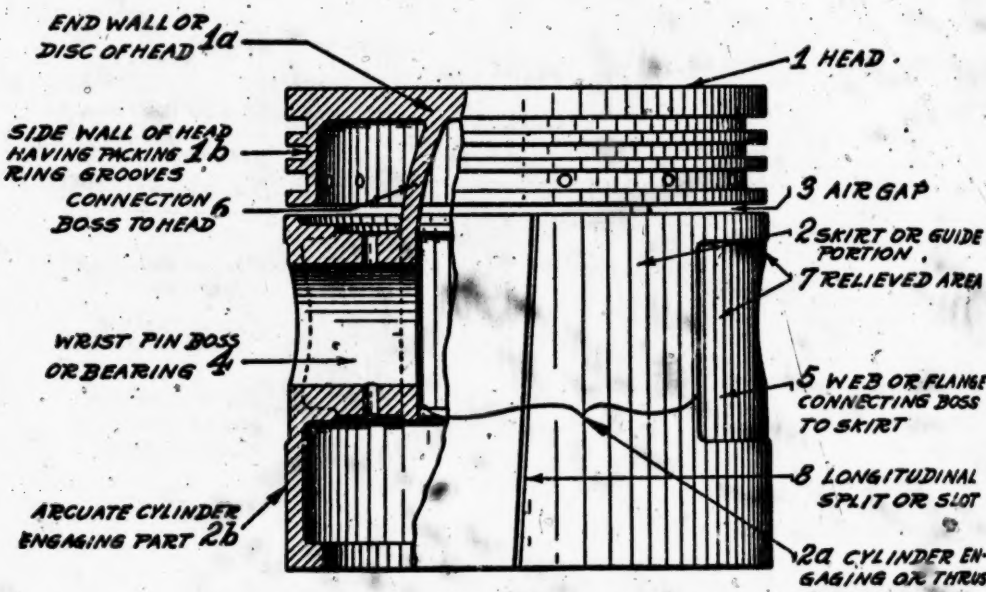
WALL OF HEAD HAVING RING GROOVES 1b
3 AIR GAP
TION BOSS TO HEAD 6
RELIEVED AREA 7
2 SKIRT OR GUIDE PORTION
WRIST PIN BOSS OR BEARING 4
8 LONGITUDINAL SPLIT OR SLOT
OR FLANGE CONNECT- BOSS TO SKIRT 5
2a CYLINDER ENGAGING OR THRUST BEARING FACE
2b ARCUATE CYLINDER ENGAGING PART

EXHIBIT CCC

Page 197:


END WALL OR DISC OF HEAD 1a
1 HEAD
SIDE WALL OF HEAD HAVING PACKING RING GROOVES 1b
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3 AIR GAP
2 SKIRT OR GUIDE PORTION
7 RELIEVED AREA
WRIST PIN BOSS OR BEARING 4
5 WEB OR FLANGE CONNECTING BOSS TO SKIRT
8 LONGITUDINAL SPLIT OR SLOT
ARCUATE CYLINDER ENGAGING PART 2b
2a CYLINDER ENGAGING OR THRUST BEARING FACE

EXHIBIT 8
RAY DAY

MAIN BRIEF FOR APPELLANT ON SECOND APPEAL.

Page 39:

If it were found necessary to construe the webs recited in the Jardine claims as being flexible, there is then ample basis in the Jardine specification description for such a construction under the strictest application of the ruling of the Supreme Court in its opinion of November 7, 1938; authority for so construing claims in light of the specification description is ample (see *Westinghouse v. Quackenbush*, 53 Fed. (2) 632, 634 (C. C. A. 6) and cases cited therein and citing the same). The propriety of so construing a claim where there was support therefor in the disclosure was recognized by the Supreme Court in its opinion in this litigation.

Page 40:

When so construed the claims are infringed by Exhibits 1, BBB and CCC as explained in detail at pages 75 to 78, 186 and 187 in our Main Brief on the first appeal. The evidence shows that these accused pistons operate like and get the same results as the Jardine piston except in degree (R. pp. 80-86, 190, 191 and 199-201). The testimony of the plaintiff's expert on this subject was not only not disputed by the defendant's expert, but insofar as he discussed the question, his testimony is in affirmance.

Page 50:

(c) The Jardine claims are entitled to be construed as containing flexible webs and, as such, are valid as an important improvement invention and entitled to such a scope, particularly in view of the effect of the decision upon the prior art, that they are infringed by Exhibits 1, 8, BBB and CCC, as we have explained at pages 68 to 78 of our Main Brief.

APPELLANT'S REPLY TO SUPPLEMENTAL BRIEF FOR APPELLEES.

Pages 14-15:

The claims do not contain the limitation in the form described as preferable. They do recite the webs. They do not use the word "bending" or "flexible."

It seems elementary for us to have to repeat here that a patentee is not limited to his preferred form, especially when he calls attention to the fact that he is illustrating particular embodiments, although his invention "is applicable to other forms of construction" (R. p. 1296, ll. 120-121) as Jardine does.

It is equally elemental that a structural feature, such as that employed by Jardine to cause the webs in his preferred form to bend at one point more than another, cannot be read into the claims for the reason that additional structure cannot be read into claims.

It is also elemental that as far as an adjective phrase is concerned such as "bending" or "flexible," such terms can be interpreted into claims under the rule that a claim can be construed in the light of the specification not to include structure, but to interpret structure. This Court collected and cited authorities on this subject in *Westinghouse v. Quackenbush*, 53 Fed. (2) 632, 634 and *Richardson v. National*, 63 Fed. (2) 289, 293. Only in case the Court violated these rules and read additional structure into the claims would there be any force to defendants' argument on this score. Even if it were the rule that a patent was limited to the specific embodiments or forms disclosed in the patent the claims would read on the second embodiment shown in Figs. 6 to 8 of the Jardine patent without having to read this particular limitation into them.

Nor is this situation to be confused with what happened in the Supreme Court. The Supreme Court held

that an element could not be read into a claim. For that reason this particular feature of structure cannot be read into the claims. The Supreme Court, however, did not hold that an element already in a claim could not be construed to be flexible in the light of the specification, where that adjective phrase, antithetical or not, *was found in the specification.* It ruled that "flexible" could not be read, as an element, into the claims of the Gulick and Maynard patents because it was not found in the specifications of those patents. Defendant asks the Court here to extend the rule laid down by the Supreme Court that web flexibility could not be read into the Gulick claims as an element, to now say that a claim may not be construed in the light of the specification to interpret the nature of the structure.

SUPPLEMENTAL BRIEF FOR APPELLEES.

Page 4:

The Jardine Patent claims do not specify that the webs are laterally flexible. However, it is appellants' contention that they must be so construed;* in fact the Jardine patent is now said to supersede Gulick.

*Although appellants contend that webs laterally flexible cannot be read into a piston patent (Brief p. 30).

Pages 25-29:

THE JARDINE PATENT.

This court did not pass on either the validity or infringement of this patent for the reason stated (92 F. [2], l. c. 337). This patent is, however, again put forward in Main. Brief for Appellant, the contention being (p. 38) that the disposal of the Gulick patent by the Supreme Court as not disclosing webs laterally flexible

> ". . . leaves Jardine the first to disclose a piston having flexible or bendable webs."

It is even stated (l. c. 44):

> "The patent of Jardine is entitled to be rated as basic and to a wide range of equivalents."

Not only is it contended (p. 40) that the claims of this Jardine patent are infringed by Exhibit 1, but also by Exhibits BBB and CCC, although this court in considering the Gulick patent, which is now said to be superseded by the Jardine patent, said (92 F. [2], l. c. 338):

> ". . . In the remaining accused devices we find no infringement."

The record shows the following, of which more complete citations will appear later:

1. **Jardine was in interferences with Long** on claims which are the prototypes of the specimen claims, and, indeed, on a claim involving webs "resiliently yieldable," or "flexed radially" (R. 2087), and the decisions in these interferences were adverse to Jardine (R. 2068-2099). Not only did the Supreme Court find that the Long pistons were "in commercial use from 1917 on," but that this Long piston was one "whose webs were concededly laterally flexible." We will show that one of plaintiff's witnesses, Burns, admitted that the Long piston (Ex. F) was sold to and in use by Franklin dealers in 1919; and another one of plaintiff's witnesses, Jeffries, knew of this piston (Ex. F) as having been used by Franklin as early as 1920, and that in this piston the webs were laterally flexible.

2. **Jardine was also involved in interferences with Hartog** on a claim involving webs "yieldingly connecting said skirt section with said head," and again the interference was adverse to Jardine (R. 2095; Hartog Cl. 4, R. 1801). The Supreme Court found that after

". . . Hartog, to the knowledge of Gulick's assignee, had specified and claimed a yieldable web, Gulick copied the Hartog claim and amended his specifications . . ."

3. **The claims involved in the interferences with Long and Hartog were canceled by Jardine,** so that it is clear that not only was Jardine not the first to make a piston having webs laterally flexible, but

". . . Whether the Examiner was right or wrong in rejecting the original claim, the court is not to inquire . . . The patentee is thereafter estopped to claim the benefit of his rejected claim or such a construction of his amended claim as would be equivalent thereto . . . he 'may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments which amount to a disclaimer.' . . . " (I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429, l. c. 443).

The above decision applies, because the judgments in the interferences were followed by the rejection of the claims involved. This principle, however, has been specifically applied to adverse judgments in interferences. Greenawalt v. American Smelting & Refining, 3 F. (2d) 658, 660,* affirmed 10 F. (2d) 98, 99** (C. C. A. 9). Type-

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*"Whatever is excluded in interference cannot be included in the patent; and whatever thus cannot be included cannot be claimed by construction."

**"The claims which were allowed to the appellant by the Examiner after the decision in the Dwight interference are not entitled to a broad interpretation. The decision of the Commissioner was final, as was also the decision of the Court on the appellant's appeal. The allowance of the appellant's claim thereafter was made in the absence of Dwight or his successors in interest, and those claims, however broad they may be, must inevitably be construed in the light of the prior decisions. In other words, they must all be narrowed by the surrender which the appellant made in the interference proceeding, and in the amendment of his claims thereupon made, and, as so limited, they can only mean that the appellant's apparatus is limited to the use of a tight-fitting cover above the whole of the ore pan."

writers Hilliardized v. Corona Typewriter, 43 F. (2d) 961, 964.***

Furthermore, an adjudication in an interference proceeding acquiesced in by the applicant, finally settles not only the rights of the parties under the issue or counts of the interference, but every question and the rights to every claim which might have been presented and determined in the interference proceedings. In re Wasserfallen (App. D. C.), 298 F. 826, 828; In re Austin, 40 F. (2d) 756, 759 (C. C. P. A.); In re Chase, 71 F. (2d) 178 (C. C. P. A.).

4. Jardine, moreover, was in interference with Gulick, and Gulick prevailed on claims which have now been eliminated by the disclaimer. However, during the interferences plaintiff was the common assignee of Gulick and Jardine, and therefore not only do the above decisions apply, but there also applies the rule that an assignee of two applications by different inventors must decide which claims are to be taken, and, having made such an election, the assignee is estopped thereby. Rule 94 of the Patent Office.* In re Dunbar, 278 F. 334 (App. D. C.).

5. None of the specimen claims 1, 8 and 11 specifies webs laterally flexible, and this is true of all the claims of the patent. Appellant cannot say that the Jardine patent claims should be construed, by reference to the specification, as having flexible or bendable webs be-

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***"After the interference decision adverse to him, Hilliard succeeded, by cancellation and amendment, in getting his patent allowed with the claims in suit. By his acceptance of that decision he foreclosed himself from claiming a construction giving to him the oblique platen shift of Brooks."

*"Parties owning applications or patents which contain conflicting claims will be required . . . to show cause why these claims shall not be eliminated from all but one of the applications or patents of common ownership."

cause it makes the contrary contention with respect to the Gulick patent (Main Brief for Appellants, p. 30).

6. The claims in issue do not distinguish from the Long patent nor from pistons on the market before Jardine filed. It is true the Examiner allowed them, but apparently this Examiner did not know or realize what was the construction of the Long pistons in commercial use, although this record now shows clearly what their construction was.

We have shown in the General Statement that although the Jardine claims do not specify that the webs are laterally flexible, assuming appellants' position, Exhibit 1 cannot be held to infringe this patent because it does not come within what Jardine specifically states constitutes the metes and bounds of web flexibility, and finally what plaintiff's own witness, Jeffries, places as the metes and bounds.

The history of the Jardine specification and claims and the interferences in which the Jardine application was involved will be further treated in an appendix.

Pages 44-45:

Plaintiff cannot prevail in this case, because

1. The Jardine piston, even as shown in the patent, constitutes a step backwards in the art over the Long pistons.

2. Jardine lost in interferences with both Long and Hartog, and, therefore, cannot claim any construction, either by the application of the rule of equivalents or otherwise, sufficiently broad to cover any of the pistons before this court.

3. Even if there is no disclosure in the Long

patent of a piston having reliefs in the regions of the bosses, and even though that was not in the Long pistons in commercial use, that was an expedient which was put on pistons from the very beginning, and was, therefore, within the purview of those skilled in the art.

4. None of the claims of the Jardine patent specify the webs as laterally flexible, and plaintiff cannot in this case change its position at will and ask this court to now read web flexibility into those claims.

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